

AMENDMENT UNDER 37 C.F.R. § 1.114(c)  
U.S. APPLICATION NO. 09/838,342  
ATTORNEY DOCKET NO. Q64164

**REMARKS**

Claims 1-21 have been examined on their merits.

Applicant herein amends claims 1, 11 and 21 to recite that the to-be-registered information is generated for each of the plurality of companies based on the specification information received from that company. Support for the amendments to claims 1, 11 and 21 can be found, for example, on page 13, lines 20-27 of the written disclosure. Entry and consideration of the amendments to claims 1, 11 and 21 is requested.

Applicant herein editorially amends claims 3 and 12 for reasons of precision of language. The amendments to claims 3 and 12 were made merely to more accurately claim the present invention and do not narrow the literal scope of the claims and thus do not implicate an estoppel in the application of the doctrine of equivalents. The amendments to claims 3 and 12 were not made for reasons of patentability.

Claims 1-21 are all the claims presently pending in the application.

1. Claims 1-21 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Hecksel *et al.* (U.S. Patent No. 6,151,707) in view of Call (U.S. Patent No. 5,913,210). Applicant traverses the rejection of claims 1-21 for at least the reasons discussed below.

The Examiner acknowledges that Hecksel *et al.* fail to teach or suggest receiving specification information that specifies at least one data item required by a plurality of companies for user registration. *See* November 20, 2003 Final Office Action, pg. 4. The Examiner asserts that Call allegedly overcomes the acknowledged deficiencies of Hecksel *et al.*

The initial burden of establishing that a claimed invention is *prima facie* obvious rests on the USPTO. *In re Piasecki*, 745 F.2d 1468, 1472 (Fed. Cir. 1984). To make its *prima facie* case of obviousness, the USPTO must satisfy three requirements:

- (i) The prior art relied upon, coupled with the knowledge generally available in the art at the time of the invention, must contain some suggestion or incentive that would have motivated to artisan to modify a reference or to combine references. *In re Fine*, 837 F.2d 1071, 1074 (Fed. Cir. 1988).
- (ii) The proposed modification of the prior art must have had a reasonable expectation of success, and that determined from the vantage point of the artisan at the time the invention was made. *Amgen, Inc. v. Chugai Pharm. Co.*, 927 F.2d 1200, 1209 (Fed. Cir. 1991).
- (iii) The prior art reference or combination of references must teach or suggest all the limitations of the claims. *In re Vaeck*, 20 U.S.P.Q.2d 1438, 1442 (Fed. Cir. 1991); *In re Wilson*, 424 F.2d 1382, 1385 (CCPA 1970).

The motivation, suggestion or teaching may come explicitly from statements in the prior art, the knowledge of one of ordinary skill in the art, or, the nature of a problem to be solved. *In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999). Alternatively, the motivation may be implicit from the prior art as a whole, rather than expressly stated. *Id.* Regardless if the USPTO relies on an express or an implicit showing of motivation, the USPTO is obligated to provide particular findings related to its conclusion, and those findings must be clear and particular. *Id.* A broad conclusionary statement, standing alone without support, is not “evidence.” *Id.*; *see also, In re*

*Zurko*, 258 F.3d 1379, 1386 (Fed. Cir. 2001).

In addition, a rejection cannot be predicated on the mere identification of individual components of claimed limitations. *In re Kotzab*, 217 F.3d 1365, 1371 (Fed. Cir. 2000). Rather, particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed. *Id.*

With respect to claim 1, the combination of Hecksel *et al.* and Call fail to teach or suggest receiving information from a plurality of companies, wherein the information specifies at least one data item that is required for user registration for that particular company, extracting the specified data item from the user information stored in a database, and generating to-be-registered information required by each company for user registration. For example, Figures 3a-3c of Hecksel *et al.* illustrate the gathering of information for user registration, but Figures 3a-3c (and their accompanying text) do not teach or suggest that such information gathering is performed on the basis of specification information that is received from a software company terminal. Instead, Hecksel *et al.* disclose a registration program that gathers information about the user, as well as program statistics, and the registration program does not use specification information received from a vendor terminal in the performance of its registration tasks. *See, e.g.*, col. 9, lines 38 to col. 11, line 55 of Hecksel *et al.* Call does not teach or suggest the receiving of specification information from a plurality of companies, wherein the specification information specifies the data needed by each company for registering that company's portion of a multi-component product. Instead, Call discloses a registration handler (203) that obtains

information needed to create a UPC code. *See* col. 4, lines 10-15 of Call. Contrary to the Examiner's assertion, Call does not disclose that the registration handler (203) sends specification information to an information generating section of a multi-component product, and that the information generating section responds with registration information containing data items requested by each company's specification information. In sum, neither Hecksel *et al.* nor Call, either alone or in combination, discloses the receipt of specification information and the generation of individual specification information based on the received specification information. Thus, Applicant believes that the Examiner cannot fulfill the "all limitations" prong of a *prima facie* case of obviousness, as required by *In re Vaeck*. Since neither Hecksel *et al.* nor Call disclose the receipt of specification and the subsequent generation of registration information based on the received specification information, Applicant believes that one of ordinary skill in the art would not be motivated to combine the two references. *In re Dembiczak* and *In re Zurko* require the Examiner to provide particularized facts on the record as to why one of skill would be motivated to combine the two references. Without a motivation to combine, a rejection based on a *prima facie* case of obviousness is improper. *In re Rouffet*, 149 F.3d 1350, 1357 (Fed. Cir. 1998)). The level of skill in the art cannot be relied upon to provide the suggestion to combine references. *Al-Site Corp. v. VSI Int'l Inc.*, 174 F.3d 1308 (Fed. Cir. 1999). The Examiner must make specific factual findings with respect to the motivation to combine references. *In re Lee*, 277 F.3d 1338, 1342-44 (Fed. Cir. 2002). The only motivational analysis provided by the Examiner is that the combination of Hecksel *et al.* and Call would provide a variety of services and functions. This analysis does not disclose why one of skill in

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the art would be motivated to combine Hecksel *et al.* and Call, especially in light of both references' deficiencies. Thus, Applicant believes that the Examiner cannot fulfill the motivation prong of a *prima facie* case of obviousness, as required by *In re Dembiczak* and *In re Zurko*.

Based on the foregoing reasons, Applicants believe that the combination of combination of Hecksel *et al.* and Call fails to disclose all of the claimed elements as arranged in claim 1, and therefore, clearly cannot render the present invention obvious as recited in claim 1. Thus, Applicant submits that claim 1 is allowable, and further believes that claims 2-10 are allowable as well, at least by virtue of their dependency from claim 1. Applicant respectfully requests that the Examiner withdraw the § 103(a) rejection of claims 1-10.

Independent claim 11 has similar recitations as independent claim 1, namely the receiving of specification information and the generation of registration information based on the received specification information. Applicant submits that claim 11 is allowable for at least the same reasons as discussed above with respect to claim 1, and further believes that claims 12-20 are allowable as well, at least by virtue of their dependency from claim 11. Applicant respectfully requests that the Examiner withdraw the § 103(a) rejection of claims 11-20.

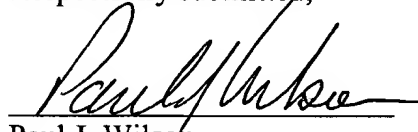
Independent claim 21 has similar recitations as independent claim 1, namely the receiving of specification information and the generation of registration information based on the received specification information. Applicant submits that claim 21 is allowable for at least the same reasons as discussed above with respect to claim 1. Applicant respectfully requests that the Examiner withdraw the § 103(a) rejection of claim 21.

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In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



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